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EXAMINER

COLBERT, E

ART UNIT	PAPER NUMBER
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2771

DATE MAILED:

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/982,438

Applicant(s)

Jecha et al

Examiner

Ella Colbert

Group Art Unit

2771



☒ Responsive to communication(s) filed on Feb 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. Claims 1-44 are pending. Claims 1, 18, 34, 40, 43, and 44 are independent claims.
2. Those applicable sections of Title 35 of United States Code not presented herein were presented in an earlier Office Action.
3. Applicants' IDS submitted on 22 February 2000 has been considered and enter as paper number 10.
4. Applicants' request for a CPA on 22 February 2000 has been entered as paper number 11.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al (US 5,892,909), hereafter Grasso.

With respect to claim 1, "sending log-on information from a client computer to a server computer, authenticating the user at the server computer" (**column 25, lines 14-24 and figure 13A (1301)**), "downloading ... from a server computer to a client computer" (**column 2, lines 38-45**), "using the authoring program at the client computer for creating a document" (**column 25, lines 25-44**), "sending the document from the client computer to the server computer" (**column 26, lines 4-27**), "translating the document from internal format to a prepress format" (**column 15, lines 62-67 and column 26, lines 48-60**), and "sending the document in a different format to a printer" (**column 13, lines 9-14**). Grasso did not teach "saving the document in an internal format at the server computer," but it would be obvious to a person of ordinary skill in the art of saving a document at the time the invention was made to have a prepress format for printing because it is easier for the user to save the document and send the document to the printer when it is translated from a programming instruction format to a printer ready format.

With respect to claim 2, "the client computer and the server computer are coupled through the Internet" (**column 3, lines 31-52**).

With respect to claim 3, "the client computer and the server computer are coupled through an Intranet" (**column 7, lines 32-40**).

With respect to claim 4, Grasso did not teach "the client computer and the server computer are communicatively coupled to one another through an Extranet," but it would be

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obvious to a person of ordinary skill in the art of Extranets at the time the invention was made to have a the Extranet coupled to the client and server computer because an Extranet when it communicates properly with the Intranet allows customers and suppliers to gain limited access to an organizations intranet which enhances the speed and efficiency of their business relationship.

With respect to claim 5, Grasso did not teach “associating the user with a particular directory on the server computer, a set of defaults such as fonts, colors, images, and commands,” or an authorization level from the group of authorization levels comprising normal and demonstrator,” but it would been obvious to a person of ordinary skill in the art of directories and setting defaults at the time the invention was made to have a an authorization level comprised of normal and demonstration because it is necessary in a computer system to have authorization levels for users which gives them certain rights such as creating, saving, and printing a document and the demonstration user is only allowed to create documents but does not have any other user rights and the administrator sees that the proper user rights are enforced in order to keep the system running efficiently. Grasso taught the authorization level of “administrator”(column 18, lines 66-67 and column 19, lines 1-40).

With respect to claim 6, Grasso taught “the authoring program downloaded from the server computer to the client computer coded in a language selected Java and Active X” (column 12, lines 3-19). Grasso did not teach the client computer being coded in Perl, C++, or C, but it would been obvious to a person of ordinary skill in the art of programming languages at the time the invention was made to have an authoring program coded in Perl, C++, and C because Perl has

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powerful string-handling features for extracting information from text files and this feature makes Perl an excellent report language when coupled with C++, C, and other Unix utilities.

With respect to claim 7, Grasso did not teach “the document being selected from a group comprising a business card, a letterhead, an envelope, and a brochure,” but it would be obvious to a person of ordinary skill in the art of documents at the time the invention was made to have a business card, a letterhead, an envelope, and a brochure because in the business world the combination of business cards, letterhead, envelopes and brochures are used to advertise the names of organizations and individuals who enhance our customer and supplier relations.

With respect to claim 8, Grasso did not teach: “the authoring program comprises a color palette area to select a color from a palette of colors,” but it would be obvious to a person of ordinary skill in the art of color palettes at the time the invention was made to have a color palette for selecting colors because creating business cards, letterhead, envelopes, and brochures using different colors enhances the appearance of the paper and makes it more pleasing to the customer or supplier when marketing goods and services.

With respect to claim 9, Grasso did not teach “the palette of colors comprises Pantone, Toyo, Focaltone, and Tru-match,” but it would be obvious to a person of ordinary skill in the art of color palettes at the time the invention was made to have a color palette with Pantone, Toyo, Focaltone, and Tru-match because these colors are well known in the art according to the Applicant’s Specification (page 10) (also see Ferguson reference 5,825,986, column 2, lines 33-

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44) and are considered the color attributes used in bar and pie charts and documents for highlighting part of a document.

With respect to claim 10, Grasso did not explicitly teach "using the authoring program at the client computer to create a document, sending the text from the client computer to the server computer for translation into an image and sending the image from the server computer back to the client," but it would be obvious to a person of ordinary skill in the art of document creation at the time the invention was made to send text from a client computer to a server computer for translation into an image because the user can create the document and send it to the server to have the program code translated into an image and the user can receive it back again as an image.

With respect to claim 11, Grasso did not teach: "the image being in a format selected from a group comprising GIF, TIFF, and JPEG." Grasso taught GIF in **column 17, lines 2-9**, but Grasso did not teach TIFF or JPEG. It would be obvious to a person of ordinary skill in the art of images at the time the invention was made to select a format in TIFF and JPEG because TIFF format is a standard file format used with the storage of graphic images and may be the only format available for using older programs (such as older versions of MacPaint) and JPEG is the standard for storing compressed images and uses less storage space in a computer system.

With respect to claim 12, Grasso did not teach "the image has a maximum resolution of 4:1," but it would be obvious to a person of ordinary skill in the art of images at the time the invention was made to have a maximum resolution because it is well known in the art (see Applicant's

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Specification on page 10) to have a ratio of a maximum image resolution of 4:1 and to translate this resolution into a desirable GIF image file format.

With respect to claim 13, Grasso did not teach “the document includes one or more images, one of the image formats selected from a group comprising encapsulated PostScript, TIFF, GIF, and JPEG.” Grasso taught encapsulated PostScript (**Appendix A (69), lines 9-13**) and GIF (**column 17, lines 2-9**). It would have obvious to a person of ordinary skill in the art of images at the time the invention was made to select a format in encapsulated PostScript, TIFF, GIF, and JPEG because encapsulated PostScript is a page-description language, TIFF format is a standard file format that is used with the storage of graphic images and may be the only format available for using older programs (such as older versions of MacPaint), GIF is a file extension used to identify bit map images, and JPEG is the standard for storing compressed images and uses less storage space in a computer.

With respect to claim 14, Grasso did not teach “one of the images has a maximum resolution of 1:1,” but it would have obvious to a person of ordinary skill in the art of images at the time the invention was made to have a maximum resolution because it is well known in the art (see Applicant’s Specification on page 10) (see Silverbrook reference 6,020,894, column 5, lines 29-40) to have a ratio of a maximum image resolution of 1:1 and translate it into a desirable image file format.

With respect to claim 15, “the different format is selected from a group comprising PostScript, HTML, PDF, and PostScript Extreme.” Grass taught the different format being in

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PostScript (**column 21, lines 4-13**) and HTML (**column 24, lines 47-55**). Grass did not teach the format being in "PDF" or "PostScript Extreme," but it would have been obvious to a person of ordinary skill in the art of formats at the time the invention was made to have formats in PostScript, HTML, PDF, and PostScript Extreme because PDF is a file extension used to identify documents that are encoded in portable document format which uses the freeware Adobe Acrobat Reader to be able to display or print a file with the .pdf extension and PostScript Extreme is Adobe's latest page description language and in this combination makes it possible for a user to create, store, save and access a variety of documents with images.

With respect to claim 16, Grass did not teach "sending the document in a different format to the printer comprising generating an electronic mail for submission to the printer with an attachment and the document in a different format," but it would have been obvious to a person of ordinary skill in the art of sending documents at the time the invention was made to generate an electronic mail to submit to the printer as an attachment because an electronic mail is in a certain format for it to be printed by the user when it is transmitted over the Internet and that format is usually a MIME type file.

With respect to claim 17, Grass did not explicitly teach "the electronic mail is MIME-compliant," however, it would have been obvious in view of his teaching of electronic mail using the Internet and Intranet (as taught in the background section, columns 2-4) for the electronic mail to be MIME compliant.

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With respect to claim 18, “a server storing an authoring program to create a document and a translation program to translate the document to a suitable prepress format” (**column 7, lines 48-54**), and “client downloading the authoring program from the server to create the document” (**column 12, lines 56-67 and column 13, lines 1-14**). Grass did not teach “uploading to the server for translation to the suitable prepress format” or “a printer receiving the document as translated to a prepress format from the server,” but it would have been obvious to a person of ordinary skill in the art of uploading a document to a server for translation and a printer receiving the document at the time the invention was made to have the translation in prepress format because in order for a user to print a document it should be in a certain format that is compatible with the printer being used.

In regard to claim 19, “wherein the server, the client and the printer are communicatively coupled to one another through the Internet” (**column 9, lines 38-42 and column 17, lines 11-22**).

With respect to claim 20, “the server, the client and the printer are coupled through an Intranet” (**column 7, lines 1-30 and column 6, lines 49-54**).

With respect to claim 21, Grass did not teach “the server, the client and the printer are coupled through an Extranet,” but it would have been obvious to a person of ordinary skill in the art of Extranets at the time the invention was made to have a client, a server, and a printer because an Extranet when it communicates properly with the Intranet allows customers and

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suppliers to gain limited access to an organizations Intranet which enhances the speed and efficiency of their business relationship.

With respect to claim 22, “the server comprises an Internet world-wide-web server” **(column 2, lines 54-64)**.

With respect to claim 23, Grass did not explicitly teach “the server comprises an Intranet world-wide-web server,” however, it would have been obvious in view of his teaching of the Internet and Intranet (as taught in the background section, column 3, lines 2-9).

With respect to claim 24, Grass did not teach “the server comprises an Extranet World-Wide-Web server,” but it would have been obvious to a person of ordinary skill in the art of Extranets at the time the invention was made to have a world-wide-web server because an Extranet when it communicates properly with the Intranet allows customers and suppliers to gain limited access to an organizations Intranet which enhances the speed and efficiency of their business relationship.

With respect to claim 25, “the authoring program runs on the client in an Internet world-wide-web browser program” **(column 3, lines 10-31)**.

With respect to claim 26, “the browser program is selected from the group essentially comprising Netscape Navigator and Microsoft Internet Explorer” **(column 27, lines 22-34 and column 24, lines 36-46)**.

With respect to claim 27, “the authoring program runs on the client in an Intranet world-wide-web browser program” **(column 3, lines 10-31)**.

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With respect to claim 28, Grass did not teach “the authoring program runs on the client in an Extranet world-wide-web browser program,” but it would have been obvious to a person of ordinary skill in the art of Extranets at the time the invention was made to have a world-wide-web browser because the client application enables a user to view HTML documents on the Extranet when it communicates properly with the Intranet.

With respect to dependent claim 29, this claim is rejected on grounds corresponding to the rejection given above for dependent claim 6.

With respect to dependent claim 30, this claim is rejected on grounds corresponding to the rejection given above for dependent claim 7.

With respect to dependent claim 31, this claim is rejected on grounds corresponding to the rejection given above for dependent claim 8.

With respect to dependent claim 32, this claim is rejected on grounds corresponding to the rejection given above for dependent claim 15.

With respect to dependent claim 33, this claim is rejected on grounds corresponding to the rejection given above for dependent claim 16.

With respect to claim 34, “a processor” (**column 6, lines 30-31**), “a computer-readable medium” (**column 6, lines 33-35**), and “a communications device” (**column 6, lines 44-49**).

Grass did not teach “an operating environment program executed by the processor from the medium” or “an authoring program downloaded from a server through a communications device and executed by a processor from a medium within the operating environment program” and “the

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authoring program being used to create a document, uploaded to the server through the communications device for translation to a prepress format and submission to a printer,” but it would have been obvious to a person of ordinary skill in the art of downloading programs and document creation at the time the invention was made to execute the downloaded program from a server and upload a created document to the server because when a user creates an Internet or Intranet document the document is downloaded and then the document is uploaded or sent to the server to transfer a copy of the document to the client and translate the document into a format to be printed.

With respect to claim 35, “ the computer-readable medium is selected from a group comprising memory and a nonvolatile storage medium” (**column 6, line 30, lines 33-35 and line 60**).

With respect to claim 36, “the communications device is selected from a group comprising a modem and a network card” (**column 6, lines 35-37**).

With respect to dependent claim 37, this claim is rejected on the same grounds corresponding to claim 25. In dependent claim 37, Applicants’ claim a operating environment program which contains steps corresponding to the computerized prepress system of dependent claim 25.

With respect to dependent claim 38, this claim is rejected on the same grounds corresponding to claim 27. In dependent claim 38, Applicants’ claim a operating environment

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program which contains steps corresponding to the computerized prepress system of dependent claim 27.

With respect to claim 39, this claim is rejected on the same grounds corresponding to claim 28. In dependent claim 39, Applicants' claim a operating environment program which contains steps corresponding to the computerized prepress system of dependent claim 28.

With respect to independent claim 40, this claim is rejected on the same grounds corresponding to claim 34. In independent claim 40, Applicants' claim a server computer which contains steps corresponding to the client computer of independent claim 34.

With respect to dependent claim 41, this claim is rejected on the same grounds corresponding to claim 35. In dependent claim 41, Applicants' claim a server computer which contains steps corresponding to the client computer of dependent claim 35.

With respect to dependent claim 42, this claim is rejected on the same grounds corresponding to claim 36. In dependent claim 42, Applicants' claim a server computer which contains steps corresponding to the client computer of dependent claim 36.

With respect to independent claim 43, this claim is rejected on the same grounds corresponding to claim 34. In independent claim 43, Applicants' a computer-readable medium which contains steps corresponding to the client computer of independent claim 34.

With respect to independent claim 44, this claim is rejected on the same grounds corresponding to claim 40. In independent claim 44, Applicants' a computer-readable medium with means which contains steps corresponding to the server computer of independent claim 40.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ferguson (5,825,986) taught determining ink requirements.

Silverbrook (6,020,894) taught a desktop publishing system with zoom ratios such as 1:1, 2:1, 3:1, and 4:1, PostScript, and JPEG.

Sperry et al (5,995,723) taught a network printing system and PostScript.

Smith et al (5,790,790) taught electronic document publishing.

INQUIRIES

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ms. Ella Colbert whose telephone number is (703) 308-7064. The Examiner can normally be reached Monday through Friday from 6:30 a.m. to 3:00 p.m. EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kim Vu, can be reached on (703)305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703)308-9051, (for formal communications intended for entry).

Or:

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(703)308-5403 (for informal or draft communications, please label

“PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703)308-9600.

Colbert

April 24, 2000


KIM YEN VU
PRIMARY EXAMINER